IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant:	Eric E. Aanenson	Examiner: David J. Parsley
Serial No.:	10/773,504	Group Art Unit: 3643
Filed:	February 6, 2010	Docket: A711.100.101
Due Date:	**April 22, 2010**	
Title:	DEEP SEA FISHING LURE	

APPEAL BRIEF UNDER 37 C.F.R. § 41.37

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir/Madam:

This Appeal Brief is submitted in support of the Notice of Appeal filed on February 22, 2010, appealing the final rejection of claims 1-4, 6, 8-15, 18-22, 24 and 36-39 of the above-identified application as set forth in the Final Office Action mailed September 4, 2009.

The U.S. Patent and Trademark Office is hereby authorized to charge Deposit Account No. 50-0471 in the amount of $270.00 for filing a Brief in Support of an Appeal as set forth under 37 C.F.R. § 41.20(b)(2). At any time during the pendency of this application, please charge any required fees or credit any overpayment to Deposit Account No. 50-0471.

Appellant respectfully requests consideration and reversal of the Examiner's rejection of pending claims 1-4, 6, 8-15, 18-22, 24 and 36-39.

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REAL PARTY IN INTEREST

The intellectual property embodied in the pending application has not been assigned. As such, the real party in interest is Eric E. Aanenson, who received title to this patent application via an assignment, which was recorded with the U.S. Patent & Trademark Office at Reel 014623 / Frame 0209.

RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to Appellant that will have a bearing on the Board's decision in the present Appeal.

STATUS OF CLAIMS

In a Final Office Action mailed September 4, 2009, claims 1-4, 6, 8-15, 18-22, 24 and 36-39 were finally rejected. Claims 5, 7 and 25-35 were allowed. Claims 1-15, 18-22 and 24-39 are pending in the application and are the subject of the present Appeal.

STATUS OF AMENDMENTS

No amendments were filed after the final rejection.

SUMMARY OF THE CLAIMED SUBJECT MATTER

Discussions about features of independent claims 1, 5, 7, 15, 24, 25, 29 and 36 can be found *at least* at the cited locations in the specification and drawings.

Claim 1 relates to a deep sea fishing lure. (Page 5, line 2 to page 8, line 5 and Figs. 1-5). The lure includes a lure body, a removable, interchangeable jacket, a first linear bank of display lights, a circular bank of display lights, a fiber optic bundle, a battery pack and an on/off switch.

The removable, interchangeable jacket is installed over and substantially covering the body and made of a light-transmissive material and configured to visually resemble a bait attractive to fish. The housing has sidewalls made of a generally light-transmissive material and an interior space for accommodation of display lights.

The first linear bank of display lights is installed in the housing parallel to an intended direction of travel of the lure through a body of water and including a plurality of spaced apart individual electric light sources viewable through the light transmissive material sidewalls of the housing. The circular bank of display lights is installed in the housing aft of the first linear bank of lights and including a plurality of spaced apart, aft facing individual electric light sources.

The fiber optic bundle has a first end connected inside the housing next to the circular light bank so as to receive light from the circular light bank, and a second end extending aft out of the housing to transmit light from the circular light bank. The battery pack is installed in the housing and connected to the light sources. The on/off switch is connected between the display light sources and the battery pack to turn the display lights on and off.

Claim 5 relates to a deep sea fishing lure. (Page 5, line 2 to page 8, line 5 and Figs. 1-5). The lure includes a lure body, a removable, interchangeable jacket, a first linear bank of display lights, a circular bank of display lights, a fiber optic bundle, a battery pack, an on/off switch, a second linear bank of display lights and at least one flasher module.

The removable, interchangeable jacket is installed over and substantially covers the body and made of a light-transmissive material and configured to visually resemble a bait attractive to fish. The body includes a housing with sidewalls made of a generally light-transmissive material and an interior space for accommodation of display lights.

The first linear bank of display lights is installed in the housing parallel to an intended direction of travel of the lure through a body of water and includes a plurality of spaced apart individual electric light sources viewable through the light transmissive material sidewalls of the housing.

The circular bank of display lights is installed in the housing aft of the first linear bank of lights and includes a plurality of spaced apart, aft facing individual electric light sources. The fiber optic bundle has a first end connected inside the housing next to the circular light bank so as to receive light from the circular light bank, and a second end extending aft out of the housing to transmit light from the circular light bank.

The battery pack is installed in the housing and connected to the light sources. The on/off switch is connected between the display light sources and the battery pack to turn the display lights on and off. The second linear bank of display lights is parallel to the first bank includes a plurality of spaced apart individual electric light sources viewable through the light transmissive material sidewalls of the housing.

The at least one flasher module is connected to the light banks operative to flash lights of the light banks on and off for the purpose of attracting fish wherein the flasher module is operative to sequentially flash lights of the light banks. The battery pack is rechargeable and includes a metal leader tube passing centrally through the lure body and the jacket for use as part of a circuit in recharging.

Claim 7 relates to a deep sea fishing lure. (Page 5, line 2 to page 8, line 5 and Figs. 1-5). The lure includes a lure body, a removable, interchangeable jacket, a first linear bank of display lights, a circular bank of display lights, a fiber optic bundle, a battery pack, an on/off switch, a second linear bank of display lights and at least one flasher module.

The removable, interchangeable jacket is installed over and substantially covers the body and made of a light-transmissive material and is configured to visually resemble a bait attractive to fish. The body includes a housing with sidewalls made of a generally light-transmissive material and an interior space for accommodation of display lights.

The first linear bank of display lights is installed in the housing parallel to an intended direction of travel of the lure through a body of water and includes a plurality of spaced apart individual electric light sources viewable through the light transmissive material sidewalls of the housing. The circular bank of display lights is installed in the housing aft of the first linear bank of lights and includes a plurality of spaced apart, aft facing individual electric light sources.

The fiber optic bundle has a first end connected inside the housing next to the circular light bank so as to receive light from the circular light bank, and a second end extending aft out of the housing to transmit light from the circular light bank. The battery pack is installed in the housing and connected to the light sources. The on/off switch is connected between the display light sources and the battery pack to turn the display lights on and off.

The second linear bank of display lights parallel to the first bank includes a plurality of spaced apart individual electric light sources viewable through the light transmissive material sidewalls of the housing. The at least one flasher module is connected to said light banks operative to flash lights of the light banks on and off for the purpose of attracting fish wherein said flasher module is operative to sequentially flash lights of the light banks. The battery pack is rechargeable and includes a metal leader tube passing centrally through the lure body and the jacket for use as part of a circuit in recharging; and the lights are green.

Claim 15 relates to a deep sea fishing lure. (Page 5, line 2 to page 8, line 5 and Figs. 1-5). The lure includes a lure body, a removable, interchangeable jacket, a circular bank of

display lights, a fiber optic bundle, a battery pack, an on/off switch and an electronic flasher module.

The removable, interchangeable jacket is installed over and substantially covers the body and made of a light-transmissive material and configured to visually resemble a bait attractive to fish. The body includes a housing with sidewalls that are made of a generally light-transmissive material and an interior space.

The circular bank of display lights is installed in the housing circularly disposed about an axis parallel to an intended direction of travel of the lure through a body of water and including a plurality of spaced apart, aft facing individual electric light sources. The fiber optic bundle has a first end connected inside the housing next to the circular light bank so as to receive light from the circular light bank, and a second end extending aft out of the housing to transmit light from the circular light bank.

The battery pack is installed in the housing and connected to the lights. The on/off switch is connected between the display lights and the battery pack to turn the display lights on and off. The electronic flasher module is connected to said light bank operative to sequentially flash the light sources of the light bank on and off for the purpose of attracting fish.

Claim 24 relates to a deep sea fishing lure. (Page 5, line 2 to page 8, line 5 and Figs. 1-5). The lure includes a lure body, a removable, interchangeable jacket, first and second parallel linear banks of display lights, a circular bank of display lights, at least one flasher module, a battery pack and an on/off switch.

The removable, interchangeable jacket is installed over and substantially covers the body and made of a translucent material and configured to visually resemble a bait attractive

to fish. The body includes a housing with sidewalls made of a generally light-transmissive material and an interior space for accommodation of display lights.

The first and second parallel linear banks of display lights are installed in the housing parallel to an intended direction of travel of the lure through a body of water and each including a plurality of spaced apart individual electric light sources viewable through the light transmissive material sidewalls of the housing.

The circular bank of display lights is installed in the housing aft of the first and second linear banks of lights and including a plurality of spaced apart, aft facing individual electric light sources. The at least one flasher module is connected to said light banks operative to flash of the light banks sequentially on and off for the purpose of attracting fish. The battery pack is installed in the housing and connected to the lights. The on/off switch is connected between the display lights and the battery pack to turn the display lights on and off.

Claim 25 relates to a deep sea fishing lure. (Page 5, line 2 to page 8, line 5 and Figs. 1-5). The lure includes a lure body, a first linear bank of display lights, a circular bank of display lights, at least one electronic flasher, a fiber optic bundle, a rechargeable battery pack, an on/off switch and a metal leader tube.

The lure body has a forward end and an aft end that trails the forward end when the body is moved in an intended direction through a body of water to catch fish. The body includes a housing comprised of light-transmissive sidewalls and an interior space for accommodation of display lights.

The first linear bank of display lights is installed in the housing parallel to an intended direction of travel of the lure through and includes a plurality of spaced apart individual electric light sources viewable through the light transmissive material sidewalls of the

housing. The circular bank of display lights is installed in the housing aft of the first linear bank of lights and includes a plurality of spaced apart, aft facing individual electric light sources.

The at least one electronic flasher module is connected to said light banks operative to flash lights of the light banks on and off for the purpose of attracting fish. The fiber optic bundle has a first end connected inside the housing next to the circular light bank so as to receive light from the circular light bank, and a second end extending aft out of the housing to transmit light from the circular light bank.

The rechargeable battery pack is installed in the housing and connected to the lights. The on/off switch is connected between the display lights and the battery pack to turn the display lights on and off. The metal leader tube passes centrally through the body and connected to the battery pack for use as part of a circuit in recharging.

Claim 29 relates to a deep sea fishing lure. (Page 5, line 2 to page 8, line 5 and Figs. 1-5). The lure includes a lure body, a jacket, a circular bank of display lights, a fiber optic bundle, a battery pack, an on/off switch, an electronic flasher module and a metal leader tube.

The jacket is installed over and substantially covers the body and made of a light-transmissive material and configured to visually resemble a bait attractive to fish. The body includes a housing with sidewalls that are made of a generally light-transmissive material and an interior space for accommodation of display lights.

The circular bank of display lights is installed in the housing circularly disposed about an axis parallel to an intended direction of travel of the lure through a body of water and includes a plurality of spaced apart, aft facing individual electric light sources. The fiber optic bundle has a first end connected inside the housing next to the circular light bank so as

to receive light from the circular light bank, and a second end extending aft out of the housing to transmit light from the circular light bank.

The battery pack is installed in the housing and connected to the lights. The on/off switch is connected between the display lights and the battery pack to turn the display lights on and off. The electronic flasher module is connected to said light bank operative to sequentially flash the light sources of the light bank on and off for the purpose of attracting fish.

The battery pack includes a plurality of rechargeable batteries, and a recharging circuit connected to the batteries and a recharging receptacle installed in the housing sidewalls. The metal leader tube passes centrally through the body and jacket and connected to the battery pack for use as part of a circuit in recharging.

Claim 36 relates to a deep sea fishing lure. (Page 5, line 2 to page 8, line 5 and Figs. 1-5). The lure includes a lure body, at least one bank of multiple, spaced apart individual electric display lights, a fiber optic bundle, a rechargeable battery pack and a leader tube.

The lure body surrounds a housing comprised of light-transmissive sidewalls and an interior space. The at least one bank of multiple, spaced apart, individual electric display lights is provided in the interior space so that it is viewable through the light transmissive sidewalls of the housing.

The fiber optic bundle transmit light aft from the display lights to outside the lure. The rechargeable battery pack for the display lights is installed in the housing. The leader tube passes centrally through the body to the battery pack, that forms part of a recharging circuit, wherein a leader wire is extendable through the leader wire.

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

I. Whether claims 1-4, 6, 12-14 and 24 were properly rejected under 35 U.S.C. §103(a) as being unpatentable over Fima, U.S. Patent No. 4,240,650 in view of Treon, U.S. Patent No. 4,799,327 in view of Garr, U.S. Patent No. 4,727,674 and further in view of Bomann, U.S. Patent No. 6,393,757.

II. Whether claim 8 was properly rejected under 35 U.S.C. §103(a) as being unpatentable over Fima, as modified by Treon, Garr and Bomann as applied to claim 4, and further in view of Liebert, U.S. Patent No. 3,952,445.

III. Whether claim 9 was properly rejected under 35 U.S.C. §103(a) as being unpatentable over Fima, as modified by Treon, Garr and Bomann as applied to claim 4, and further in view of Ray, U.S. Patent No. 4,175,348.

IV. Whether claim 10 was properly rejected under 35 U.S.C. §103(a) as being unpatentable over Fima, as modified by Treon, Garr and Bomann as applied to claim 4, and further in view of Malphrus, U.S. Patent No. 4,516,350.

V. Whether claims 11 was properly rejected under 35 U.S.C. §103(a) as being unpatentable over Fima, as modified by Treon, Garr and Bomann as applied to claim 4, and further in view of West, U.S. Patent No. 6,581,319.

VI. Whether claims 15 and 18-19 were properly rejected under 35 U.S.C. §103(a) as being unpatentable over Fima in view of Garr and Bomann.

VII. Whether claim 20 was properly rejected under 35 U.S.C. §103(a) as being unpatentable over Fima, as modified by Garr and Bomann as applied to claim 19, and further in view of Liebert.

VIII. Whether claim 21 was properly rejected under 35 U.S.C. §103(a) as being unpatentable over Fima, as modified by Garr and Bomann as applied to claim 20, and further in view of Ray.

IX. Whether claim 22 was properly rejected under 35 U.S.C. §103(a) as being unpatentable over Fima, as modified by Garr, Bomann and Liebert as applied to claim 20, and further in view of Malphrus.

XI. Whether claims 36-37 and 39 were properly rejected under 35 U.S.C. §103(a) as being unpatentable over Fima in view of King et al., U.S. Patent No. 6,647,659.

XII. Whether claim 38 was properly rejected under 35 U.S.C. §103(a) as being unpatentable over Fima, as modified King, and further in view of Ray.

ARGUMENT

I. The Applicable Law

Patent Examiners carry the responsibility of making sure that the standard of patentability enunciated by the Supreme Court and by the Congress is applied in each and every case. MPEP § 2141. The Examiner bears the burden under 35 U.S.C. § 103 in establishing a prima facie case of obviousness. *In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

To establish a prima facie case of obviousness, each of these three criteria must be met: (1) there must be some suggestion or motivation to modify or combine the reference teachings; (2) there must exist a reasonable expectation of success; and (3) the references must teach or suggest all of the claim limitations. MPEP § 2143.

Patent Office policy is to follow *Graham v. John Deere Co.* in the consideration and determination of obviousness under 35 U.S.C. § 103. MPEP § 2141. The four Graham

factual inquiries that provide the basis for an obviousness determination include: (1) determining the scope and content of the prior art; (2) ascertaining the differences between the prior art and the claims at issue; (3) resolving the level of ordinary skill in the pertinent art; and (4) evaluating evidence of secondary considerations.

In addition, the Manual of Patent Examining Procedure at Section 2141 provides these basic tenants of patent law that must be adhered to:

A. The claimed invention must be considered as a whole;

B. The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;

C. The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and

D. Reasonable expectation of success is the standard with which obviousness is determined.

The U.S. Patent & Trademark Office has published guidelines, effective October 10, 2007, that will assist Office personnel in making a "proper determination of obviousness under 35 U.S.C. § 103." Fed. Reg., Vol. 72, No. 195. The guidelines recognize that differences between the cited art and the claimed invention are likely to exist, and provides that "The gap between the prior art and the claimed invention may not be 'so great as to render the [claim] nonobvious to one reasonably skilled in the art.'" *Dann v. Johnston*, 425 U.S. 219, 230, 189 USPQ 257, 261 (1976).

It is believed that the diverse collection of cited references include gaps in their respective disclosures that is so great that no basis exists for establishing a prima facie case of obviousness in light of the cited references.

Recently, the Supreme Court offered guidance on how references should be viewed when conducting an obviousness determination. The Supreme Court's position is: "A patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art." *KSR Int'l Co. v. Teleflex, Inc.,* 127 S. Ct. 1727, 1731; 82 USPQ2d 1385, 1389 (2007)(*emphasis added*). In making this point, the Court noted that "[I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does." *KSR,* 127 S. Ct. at 1738; 82 USPQ2d at 1396 (*emphasis added*).

In addition, the Court in the *KSR* decision offers this reminder: "A fact finder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning." *KSR,* 127 S. Ct. at 1739; 82 USPQ2d at 1397 (citing to *Graham,* 38 U.S. 1, 36 in warning against a temptation to read into the prior art the teachings of the invention at issue and instructing courts to guard against slipping into the use of hindsight).

II. Rejection of Claims 1-4, 6, 12-14 and 24 under 35 U.S.C. §103(a) as being unpatentable over Fima in view of Treon, Garr and Bomann.

Claims 1-4, 6, 12-14 and 24 were rejected under 35 U.S.C. §103(a) as being unpatentable over Fima, U.S. Patent No. 4,240,650 ("Fima") in view of Treon, U.S. Patent No. 4,799,327 ("Treon") in view of Garr, U.S. Patent No. 4,727,674 ("Garr") and further in view of Bomann, U.S. Patent No. 6,393,757 ("Bomann").

The Examiner cited Fima for disclosing a lure body having many of the aspects of the claimed invention.

However, the Examiner acknowledged that Fima does not disclose the following elements:

(1) a light source as a linear bank of lights;

(2) a circular bank of display lights in the housing aft of the first lights;

(3) a jacket that is removable and interchangeable.

The Examiner contended that it would have been obvious to combine individual features from each of the secondary references with the Fima fishing lure to produce the claimed invention.

While the Applicants agree that Fima does not disclose the above elements, Applicants respectfully dispute that the secondary references disclose the above elements, as they are recited in the present application. Additionally, it is respectfully submitted that other limitations of the claimed invention are not disclosed by Fima.

First, independent claims 1 and 24 include the limitations of a lure body including a housing with sidewalls made of a **generally light-transmissive material**. Fima, in view of Treon, Garr and Bomann do not teach or reasonably make obvious these limitations.

Fima discloses body 12 and main section 20 made from a material that is not light transmissive. Fima further discloses light conductors which carry light to one or more locations on the exterior of the lure. (col. 1, lines 50-51)

Fima discloses two bundles of light conducting optical fibers to direct light from light sources 38, 40 to simulated eyes 46 and tail 48. (See Figs. 1 and 3) As such, Fima teaches light conducting optical fibers directing the light from a light source to select exterior locations on the lure body, the eyes 46 and tail 48. Therefore, contrary to claims 1 and 24 wherein the lure body including a housing with sidewalls is made of a generally light-

transmissive material, Fima teaches that only select locations such as the eyes and tail are light transmissive.

Second, independent claims 1 and 24 also include the limitations of a **first linear bank of display lights** installed in the housing parallel to an intended direction of travel of the lure through a body of water and including **a plurality of spaced apart individual electric light sources viewable through the light transmissive material sidewalls** of the housing. Fima, Treon, Garr and Bomann, either alone or in combination, do not teach or reasonably make obvious these limitations.

As acknowledged by the Examiner, Fima does not disclose the first light source as a linear bank of lights. In this respect the Examiner cited to Figure 1 of Treon. However, Treon discloses light source and distribution module X as an elongated tube 10. (See Fig. 1)

Further, Treon discloses the bundle of optical fibers F provided to distribute light emitted from LED 32. (col. 3, line 66 to col. 4, line 1) As illustrated in Fig. 2 of Treon, only one LED 32 is disclosed. Treon discloses the manner in which the single light source is distributed within the lure to be bundles 38, 39 and 40 of optical fibers extending from the single LED light source 32 and projecting out of the lure body. (col. 4, lines 1-35, see also Figs. 2, 4 and 5)

Additionally, Treon discloses bundle 38 extending to the dorsal area, bundle 39 extending to the ventral area, and bundle 40 extending to the tail area. (col. 4, lines 13-28, see also Fig. 1) As illustrated in Fig. 1, these areas are not linear, but instead include the top, bottom and end of the lure. In this manner, Treon does not teach or suggest the limitations a first linear bank of display lights installed in the housing parallel to an intended direction of travel of the lure through a body of water and including a plurality of spaced apart individual

electric light sources viewable through the light transmissive material sidewalls of the housing as recited in claims 1 and 24.

Third, independent claims 1 and 24 include the limitations of a circular bank of display lights installed **in the housing aft of the first linear bank of lights** and including a plurality of spaced apart, **aft facing individual electric light sources**. Fima, Treon, Garr and Bomann, either alone or in combination, do not teach or reasonably make obvious these limitations.

The Office Action cited the light emergence points 3 of Garr for the above limitations. Initially, Garr discloses a light source contained in the body of the lure and light brought to the surface by fiber optics. (Abstract) Garr further discloses the light emerging from the ends of optionally faceted fiber optics or external LED's at 3. (col. 4, lines 44-46)

Additionally, Garr discloses light is fed in four 90° quadrants from the mid body of the lure and one acrylic light pipe or fiber optic extended out the end of the lure. (col. 5, lines 21-23, 32-35, 45-47, and 57-59) As illustrated in Figs. 1-2 of Garr, the light emergences points 3 are placed in two sections of quadrants at the mid body.

In this manner, Garr teaches light emergence points 3 placed in two sections of light emergence points placed at 90° intervals around the mid body of the lure, one section aft of the other, and one singular light emergence point 3 at the aft end of the lure. This is unlike the circular bank of display lights installed in the housing aft of the first linear bank of lights as recited in claims 1 and 24.

Further, Garr discloses light emergence points 3 and external LED's 24 extending directly outward from the end of the light pipes and interior of the lure. (See Figs. 1-3) Unlike the aft facing light sources of claim 1, Garr discloses the light pipes extend radially from the interior of the lure to the exterior of the lure. (See Figs. 3 and 9) As such, Garr does

not teach a plurality of spaced apart, aft facing individual electric light sources as recited in claims 1 and 24.

In sum, the combination of Fima, in view of Treon, in view of Garr, in further view of Bomann, as applied to claims 1 and 24 do not teach or reasonably make obvious the above limitations. It is respectfully submitted that the cited art fails to teach or reasonably make obvious at least these features recited by claims 1 and 24. Thus, claims 1 and 24 recite allowable subject matter.

Additionally, the Examiner fails to cite any motivation to modify Fima to include the above noted limitations, notably, a linear bank of display lights. Fima relates to a fishing lure in which light sources are internally mounted for protection by the body of the lure and the light is transmitted to exterior locations by optical conductors. (Abstract)

The background of Fima discusses that the disadvantages to be overcome include awkward or unnatural overall appearance of fishing lures. (col. 1, lines 16-21) Light conductors carry the light to simulated eyes 46 and tail 48 on the exterior of the lure from the two light sources 38/40. (col. 1, lines 51-52; Figs. 1 and 3)

In contrast, the linear bank of display lights of claims 1 and 24 is not comprised of two light sources transmitted to simulated eyes and tail on the exterior by optical conductors, but include a plurality of individual electric light sources viewable through light transmissive material sidewalls of the housing.

Thus, Fima teaches away from the modifications advanced by the Examiner. Without a requisite motivation to modify, it is respectfully submitted that the Examiner's rejection of claims 1 and 24 is traversed, and withdrawal of that rejection is respectfully requested.

Claims 2-4, 6, and 12-14 further define patentably distinct independent claim 1. As previously described, the combination of Fima, in view of Treon, in view of Garr, in further

view of Bomann, as applied to claims 1 and 24 do not teach or reasonably make obvious the above limitations. Reconsideration and withdrawal of this rejection are respectfully requested.

III. Rejection of Claim 8 under 35 U.S.C. §103(a) as being unpatentable over Fima in view of Treon, Garr, Bomann and Liebert.

Claim 8 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Fima, as modified by Treon, Garr and Bomann as applied to claim 4, and further in view of Liebert, U.S. Patent No. 3,952,445 ("Liebert").

After acknowledging that "Fima as modified by Treon and Garr does not disclose a clear epoxy resin filling the interior space of the housing and encapsulating the items therein," the Examiner contended that "Liebert does disclose a clear epoxy resin – at 10, filling the interior space of the housing – at 17 or 19, and encapsulating items therein – see for example figures 3 and 5." The Examiner then contended that it would have been obvious to combine the references to produce the claimed structure.

Liebert does not overcome the deficiencies set forth above with respect to the combination of Fima, Treon, Garr, Bomann and Liebert. As such, the combination of Fima, Treon, Garr, Bomann and Liebert does not render claim 11 obvious. Reconsideration and withdrawal of this rejection are respectfully requested.

IV. Rejection of Claim 9 under 35 U.S.C. §103(a) as being unpatentable over Fima in view of Treon, Garr, Bomann and Ray.

Claim 9 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Fima, as modified by Treon, Garr and Bomann as applied to claim 4, and further in view of Ray, U.S. Patent No. 4,175,348 ("Ray").

After acknowledging that "Fima as modified by Treon, Garr and Bomann does not disclose the on/off switch is a magnetically actuated reed switch – at 30, operable through the use of a magnet – at 34, 36, held exteriorly to the housing – at 32 – see for example figures 1-2," the Examiner contended that "Ray does disclose the on/off switch is a magnetically actuated reed switch – at 30, operable through the use of a magnet – at 34, 36, held exteriorly to the housing – at 32 – see for example figures 1-2 ." The Examiner then contended that it would have been obvious to combine the references to produce the claimed structure.

Ray does not overcome the deficiencies set forth above with respect to the combination of Fima, Treon, Garr and Bomann. As such, the combination of Fima, Treon, Garr, Bomann and Ray does not render claim 9 obvious. Reconsideration and withdrawal of this rejection are respectfully requested.

V. Rejection of Claim 10 under 35 U.S.C. §103(a) as being unpatentable over Fima in view of Treon, Garr, Bomann and Malphrus.

Claim 10 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Fima, as modified by Treon, Garr and Bomann as applied to claim 4, and further in view of Malphrus, U.S. Patent No. 4,516,350 ("Malphrus").

After acknowledging that "Fima as modified by Treon, Garr and Bomann does not disclose the jacket is configured in the likeness of a squid," the Examiner contended that "Malphrus does disclose the jacket – at 10-14, is configured in the likeness of a squid – see for example figures 1-3." The Examiner then contended that it would have been obvious to combine the references to produce the claimed structure.

Malphrus does not overcome the deficiencies set forth above with respect to the combination of Fima, Treon, Garr and Bomann. As such, the combination of Fima, Treon,

Garr, Bomann and Malphrus does not render claim 10 obvious. Reconsideration and withdrawal of this rejection are respectfully requested.

VI. Rejection of Claim 11 under 35 U.S.C. §103(a) as being unpatentable over Fima in view of Treon, Garr, Bomann and West.

Claim 11 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Fima, as modified by Treon, Garr and Bomann as applied to claim 4, and further in view of West, U.S. Patent No. 6,581,319 ("West").

After acknowledging that "Fima as modified by Treon, Garr and Bomann does not disclose the battery pack includes a plurality of rechargeable batteries and a recharging circuit connected to the batteries and a recharging receptacle installed in the housing sidewalls," the Examiner contended that "West does disclose the battery pack – at 26, includes a plurality of rechargeable batteries – see for example figures 1-2 and column 3 lines 48-60, and a recharging circuit connected to the batteries – see for example at 22-38 in figure 2, and a recharging receptacle installed in the housing sidewalls – see for example at 12-18 in figure 2." The Examiner then contended that it would have been obvious to combine the references to produce the claimed structure.

West does not overcome the deficiencies set forth above with respect to the combination of Fima, Treon, Garr and Bomann. As such, the combination of Fima, Treon, Garr, Bomann and West does not render claim 11 obvious. Reconsideration and withdrawal of this rejection are respectfully requested.

VII. Rejection of Claims 15 and 18-19 under 35 U.S.C. §103(a) as being unpatentable over Fima in view of Garr and Bomann.

Claims 15 and 18-19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Fima in view Garr and Bomann.

After acknowledging that "Treon, Garr and Bomann does not disclose the battery pack includes a plurality of rechargeable batteries and a recharging circuit connected to the batteries and a recharging receptacle installed in the housing sidewalls," the Examiner contended that "Bomann does disclose the jacket – at 32, made of light transmissive sidewalls – see column 8 lines 49-63, that is removable and interchangeable and shaped as a bait – see figures 2-4." The Examiner then contended that it would have been obvious to combine the references to produce the claimed structure.

Additionally, independent claim 15 includes the limitations of an electronic flasher module connected to said light bank operative to **sequentially flash the light sources** of the light bank on and off for the purpose of attracting fish. Fima in view of Garr and Bomann do not teach or reasonably make obvious these limitations.

The Examiner contends that Fima as modified by Garr disclose the above limitations and specifically cites to Fima. However, Fima discloses:

> a circuit that powers the parallel light sources 38 and 40 is completed only when both battery terminals 52 and 54 are simultaneously in engagement with stationary contacts 34. The lights sources are, therefore, energized intermittently as the battery 50 rolls back and forth within the guideway 24 under the force of gravity due to the rocking action of the lure 10. (emphasis added)

In this manner, Fima teaches that light sources 38 and 40 are energized together, at the same time, as they are connected in parallel. Further, Fima teaches that the light sources are either energized or not energized simultaneously, in response to the battery 50 intermittent electrical connections. Further, unlike the limitations of claim 15 in which an electronic flasher module is connect to said light bank, Fima discloses that the battery is only intermittently connected to the light sources 38 and 40 as the battery 50 rolls back and forth. As such, Fima as modified by Garr does not disclose or reasonably make obvious the above limitations.

Based upon the preceding comments, it is submitted that claim 15 is not obvious when viewed in light of the cited references. Claims 18 and 19 depend from independent claim 15 and, as such, are also not obvious. Reconsideration and withdrawal of this rejection are respectfully requested.

VIII. Rejection of Claim 20 under 35 U.S.C. §103(a) as being unpatentable over Fima in view of Garr, Bomann and Liebert.

Claim 20 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Fima, as modified by Garr and Bomann as applied to claim 19, and further in view of Liebert.

After acknowledging that "Fima as modified by Garr and Bomann does not disclose a clear epoxy resin filling the interior space of the housing and encapsulating the items therein," the Examiner contended that "Liebert does disclose a clear epoxy resin – at 10, filling the interior space of the housing at 17 or 19, and encapsulating the items therein – see for example figures 3 and 5." The Examiner then contended that it would have been obvious to combine the references to produce the claimed structure.

Liebert does not overcome the deficiencies set forth above with respect to the combination of Fima, Garr and Bomann. As such, the combination of Fima, Garr, Bomann and Liebert does not render claim 20 obvious. Reconsideration and withdrawal of this rejection are respectfully requested.

XI. Rejection of Claim 21 under 35 U.S.C. §103(a) as being unpatentable over Fima in view of Garr, Bomann and Ray.

Claim 21 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Fima, as modified by Garr and Bomann as applied to claim 20, and further in view of Ray.

After acknowledging that "Garr and Bomann does not disclose the on/off switch is a magnetically actuated reed switch operable through the use of a magnet held exeriorly to the house," the Examiner contended that "Ray does disclose the on/off switch is a magnetically actuated reed switch – at 30, operable through the use of a magnet – at 34, 36, held exteriorly to the housing – at 32- see for example figures 1-2 ." The Examiner then contended that it would have been obvious to combine the references to produce the claimed structure.

Ray does not overcome the deficiencies set forth above with respect to the combination of Fima, Garr and Bomann. As such, the combination of Fima, Garr, Bomann and Ray does not render claim 21 obvious. Reconsideration and withdrawal of this rejection are respectfully requested.

X. Rejection of Claim 22 under 35 U.S.C. §103(a) as being unpatentable over Fima in view of Garr, Bomann, Liebert and Malphrus.

Claim 22 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Fima, as modified by Garr, Bomann and Liebert as applied to claim 20, and further in view of Malphrus.

After acknowledging that "Fima as modified by Garr, Bomann and Liebert does not disclose the jacket is configured in the likeness of a squid," the Examiner contended that "Malphrus does disclose the jacket – at 10-14, is configured in the likeness of a squid – see for example figures 1-3." The Examiner then contended that it would have been obvious to combine the references to produce the claimed structure.

Malphrus does not overcome the deficiencies set forth above with respect to the combination of Fima, Garr, Bomann and Liebert. As such, the combination of Fima, Garr, Bomann, Liebert and Malphrus does not render claim 22 obvious. Reconsideration and withdrawal of this rejection are respectfully requested.

XI. Rejection of Claims 36-37 and 39 under 35 U.S.C. §103(a) as being unpatentable over Fima in view of King.

Claims 36-37 and 39 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Fima in view of King et al., U.S. Patent No. 6,647,659 ("King").

After acknowledging that "Fima does not disclose a rechargeable battery pack for the display lights installed in the housing and a leader tube, passing centrally through the body to the battery pack, that forms part of recharging circuit," the Examiner contended that "King discloses a rechargeable battery pack – at 21, for the display light – at 29, installed in the housing – see Figure 3, and a leader tube – at 35, passing centrally through the body to the battery pack – see Figure 3, that forms part of the recharging circuit – see figure 3." The Examiner then contended that it would have been obvious to combine the references to produce the claimed structure.

Independent claim 36 includes the limitations of a leader tube, passing centrally through the body to the battery pack, that form part of a recharging circuit, wherein a leader wire is extendable through the leader wire. Fima in view of King, either alone or in combination, do not teach or suggest these limitations.

While King et al. discloses various wires that are connected to the battery, the light source and hooks on the outside of the lure, King et al. does not disclose a leader tube that passes through the lure through which the leader wire extends. Reference numeral 35 in King is for a switch housing in which metal ball bearing 37 moves. To the contrary, the figures in King et al. illustrate that the lure is completely enclosed.

As is discussed and illustrated in the present application and as is common knowledge to those of ordinary skill in this field, a leader tube is adapted to receive a leader wire.

Based upon the preceding comments, it is submitted that claim 36 is not obvious when viewed in light of the cited references. Claims 37 and 39 depend from independent claim 36 and, as such, are also not obvious. Reconsideration and withdrawal of this rejection are respectfully requested.

XII. Rejection of Claim 38 under 35 U.S.C. §103(a) as being unpatentable over Fima in view of Ray and King.

Claim 38 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Fima, as modified King as applied to claim 37, and further in view of Ray.

After acknowledging that "Fima as modified by King et al. does not disclose the on/off switch is a magnetically acutated reed switch operably through the use of a magnet held exteriorly to the house," the Examiner contended that "Ray does disclose the on/off switch is a magnetically actuated reed switch." The Examiner then contended that it would have been obvious to combine the references to produce the claimed structure.

Ray does not overcome the deficiencies set forth above with respect to the combination of Fima and King. As such, the combination of Fima, King and Ray does not render claim 38 obvious. Reconsideration and withdrawal of this rejection are respectfully requested.

CONCLUSION

Appellant submits that the Examiner has presented the best available references against the claimed subject matter of the pending application. Reversal of the rejections of claims 1-4, 6, 8-25, 28-22, 24 and 36-39 is respectfully requested. After such reversal, it is submitted that claims 1-15, 18-22 and 24-39 are in condition for allowance and such action is respectfully requested.

Any inquiry regarding this Appeal Brief should be directed to Michael A. Bondi at Telephone No. (612) 573-2004, Facsimile No. (612) 573-2005. In addition, all correspondence should continue to be directed to the following address:

Dicke, Billig & Czaja, PLLC
Fifth Street Towers, Suite 2250
100 South Fifth Street
Minneapolis, MN 55402

Respectfully submitted,

Eric E. Aanenson

By his attorneys,

DICKE, BILLIG & CZAJA, PLLC
Fifth Street Towers, Suite 2250
100 South Fifth Street
Minneapolis, MN 55402
Telephone: (612) 767-2512
Facsimile: (612) 573-2005

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MAB:sy:cjs

/Michael A. Bondi/
Michael A. Bondi
Reg. No. 39,616

CLAIMS APPENDIX

1. A deep sea fishing lure comprising:

a lure body;

a removable, interchangeable jacket installed over and substantially covering the body and made of a light-transmissive material and configured to visually resemble a bait attractive to fish;

said body including a housing with sidewalls made of a generally light-transmissive material and an interior space for accommodation of display lights;

a first linear bank of display lights installed in the housing parallel to an intended direction of travel of the lure through a body of water and including a plurality of spaced apart individual electric light sources viewable through the light transmissive material sidewalls of the housing;

a circular bank of display lights installed in the housing aft of the first linear bank of lights and including a plurality of spaced apart, aft facing individual electric light sources;

a fiber optic bundle having a first end connected inside the housing next to the circular light bank so as to receive light from the circular light bank, and a second end extending aft out of the housing to transmit light from the circular light bank;

a battery pack installed in the housing and connected to the light sources; and

an on/off switch connected between the display light sources and the battery pack to turn the display lights on and off.

2. The fishing lure of claim 1 including:

a second linear bank of display lights parallel to the first bank including a plurality of spaced apart individual electric light sources viewable through the light transmissive material sidewalls of the housing.

3. The fishing lure of claim 2 including:

at least one flasher module connected to said light banks operative to flash lights of the light banks on and off for the purpose of attracting fish.

4. The fishing lure of claim 3 wherein:

said flasher module is operative to sequentially flash lights of the light banks.

5. A deep sea fishing lure comprising:

a lure body;

a removable, interchangeable jacket installed over and substantially covering the body and made of a light-transmissive material and configured to visually resemble a bait attractive to fish;

said body including a housing with sidewalls made of a generally light-transmissive material and an interior space for accommodation of display lights;

a first linear bank of display lights installed in the housing parallel to an intended direction of travel of the lure through a body of water and including a plurality of spaced apart individual electric light sources viewable through the light transmissive material sidewalls of the housing;

a circular bank of display lights installed in the housing aft of the first linear bank of lights and including a plurality of spaced apart, aft facing individual electric light sources;

a fiber optic bundle having a first end connected inside the housing next to the circular light bank so as to receive light from the circular light bank, and a second end extending aft out of the housing to transmit light from the circular light bank;

a battery pack installed in the housing and connected to the light sources;

an on/off switch connected between the display light sources and the battery pack to turn the display lights on and off;

a second linear bank of display lights parallel to the first bank including a plurality of spaced apart individual electric light sources viewable through the light transmissive material sidewalls of the housing;

at least one flasher module connected to said light banks operative to flash lights of the light banks on and off for the purpose of attracting fish wherein said flasher module is operative to sequentially flash lights of the light banks; and

said battery pack is rechargeable and including a metal leader tube passing centrally through the lure body and the jacket for use as part of a circuit in recharging.

6. The fishing lure of claim 4 wherein:

the light sources of said light banks are light emitting diodes.

7. A deep sea fishing lure comprising:

a lure body;

a removable, interchangeable jacket installed over and substantially covering the body and made of a light-transmissive material and configured to visually resemble a bait attractive to fish;

said body including a housing with sidewalls made of a generally light-transmissive material and an interior space for accommodation of display lights;

a first linear bank of display lights installed in the housing parallel to an intended direction of travel of the lure through a body of water and including a plurality of spaced apart individual electric light sources viewable through the light transmissive material sidewalls of the housing;

a circular bank of display lights installed in the housing aft of the first linear bank of lights and including a plurality of spaced apart, aft facing individual electric light sources;

a fiber optic bundle having a first end connected inside the housing next to the circular light bank so as to receive light from the circular light bank, and a second end extending aft out of the housing to transmit light from the circular light bank;

a battery pack installed in the housing and connected to the light sources;

an on/off switch connected between the display light sources and the battery pack to turn the display lights on and off;

a second linear bank of display lights parallel to the first bank including a plurality of spaced apart individual electric light sources viewable through the light transmissive material sidewalls of the housing;

at least one flasher module connected to said light banks operative to flash lights of the light banks on and off for the purpose of attracting fish wherein said flasher module is operative to sequentially flash lights of the light banks; and

said battery pack is rechargeable and including a metal leader tube passing centrally through the lure body and the jacket for use as part of a circuit in recharging; and the lights are green.

8. The fishing lure of claim 4 including:

a clear epoxy resin filling the interior space of the housing and encapsulating the items therein.

9. The fishing lure of claim 4 wherein:

said on/off switch is a magnetically actuated reed switch operable through the use of a magnet held exteriorly to the housing.

10. The fishing lure of claim 4 wherein:

said jacket is configured in the likeness of a squid.

11. The fishing lure of claim 4 wherein:

said battery pack includes a plurality of rechargeable batteries, and a recharging circuit connected to the batteries and a recharging receptacle installed in the housing sidewalls.

12. The fishing lure of claim 1 including:

at least one flasher module connected to said light banks operative to flash light sources of the light banks on and off for the purpose of attracting fish.

13. The fishing lure of claim 12 wherein:

said flasher module is operative to sequentially flash light sources of the light banks.

14. The fishing lure of claim 13 wherein:

said flasher module is a connected to the first linear light bank operative to sequentially flash the light sources, and including a second flasher module connected to the circular light bank operative to sequentially flash the light sources of the circular light bank.

15. A deep sea fishing lure comprising:

a lure body;

a removable, interchangeable jacket installed over and substantially covering the body and made of a light-transmissive material and configured to visually resemble a bait attractive to fish;

said body including a housing with sidewalls that are made of a generally light-transmissive material and an interior space;

a circular bank of display lights installed in the housing circularly disposed about an axis parallel to an intended direction of travel of the lure through a body of water and including a plurality of spaced apart, aft facing individual electric light sources;

a fiber optic bundle having a first end connected inside the housing next to the circular light bank so as to receive light from the circular light bank, and a second end extending aft out of the housing to transmit light from the circular light bank;

a battery pack installed in the housing and connected to the lights;

an on/off switch connected between the display lights and the battery pack to turn the display lights on and off;

an electronic flasher module connected to said light bank operative to sequentially flash the light sources of the light bank on and off for the purpose of attracting fish.

16-17. (Cancelled).

18. The fishing lure of claim 15 wherein:

the light sources of said light bank are light emitting diodes.

19. The fishing lure of claim 18 wherein:

the lights are green.

20. The fishing lure of claim 15 including:

a clear epoxy resin filling the interior space of the housing and encapsulating the items therein.

21. The fishing lure of claim 20 wherein:

said on/off switch is a magnetically actuated reed switch operable through the use of a magnet held exteriorly to the housing.

22. The fishing lure of claim 20 wherein:

said jacket is configured in the likeness of a squid.

23. (Cancelled)

24. A deep sea fishing lure comprising:

a lure body;

a removable, interchangeable jacket installed over and substantially covering the body and made of a translucent material and configured to visually resemble a bait attractive to fish;

said body including a housing with sidewalls made of a generally light-transmissive material and an interior space for accommodation of display lights;

first and second parallel linear banks of display lights installed in the housing parallel to an intended direction of travel of the lure through a body of water and each including a plurality of spaced apart individual electric light sources viewable through the light transmissive material sidewalls of the housing;

a circular bank of display lights installed in the housing aft of the first and second linear banks of lights and including a plurality of spaced apart, aft facing individual electric light sources;

at least one flasher module connected to said light banks operative to flash of the light banks sequentially on and off for the purpose of attracting fish.

a battery pack installed in the housing and connected to the lights; and

an on/off switch connected between the display lights and the battery pack to turn the display lights on and off.

25. A deep sea fishing lure comprising:

a lure body having a forward end and an aft end that trails the forward end when the body is moved in an intended direction through a body of water to catch fish;

said body including a housing comprised of light-transmissive sidewalls and an interior space for accommodation of display lights;

a first linear bank of display lights installed in the housing parallel to an intended direction of travel of the lure through and including a plurality of spaced apart individual electric light sources viewable through the light transmissive material sidewalls of the housing;

a circular bank of display lights installed in the housing aft of the first linear bank of lights and including a plurality of spaced apart, aft facing individual electric light sources;

at least one electronic flasher module connected to said light banks operative to flash lights of the light banks on and off for the purpose of attracting fish;

a fiber optic bundle having a first end connected inside the housing next to the circular light bank so as to receive light from the circular light bank, and a second end extending aft out of the housing to transmit light from the circular light bank;

a rechargeable battery pack installed in the housing and connected to the lights;

an on/off switch connected between the display lights and the battery pack to turn the display lights on and off; and

a metal leader tube passing centrally through the body and connected to the battery pack for use as part of a circuit in recharging.

26. The fishing lure of claim 25 including:

a second linear bank of display lights parallel to the first bank.

27. The fishing lure of claim 26 wherein:

the light sources of said light banks are light emitting diodes.

28. The fishing lure of claim 27 wherein:

said on/off switch is a magnetically actuated reed switch operable through the use of a magnet held exteriorly to the housing.

29. A deep sea fishing lure comprising:

a lure body;

a jacket installed over and substantially covering the body and made of a light-transmissive material and configured to visually resemble a bait attractive to fish;

said body including a housing with sidewalls that are made of a generally light-transmissive material and an interior space for accommodation of display lights;

a circular bank of display lights installed in the housing circularly disposed about an axis parallel to an intended direction of travel of the lure through a body of water and including a plurality of spaced apart, aft facing individual electric light sources;

a fiber optic bundle having a first end connected inside the housing next to the circular light bank so as to receive light from the circular light bank, and a second end extending aft out of the housing to transmit light from the circular light bank;

a battery pack installed in the housing and connected to the lights;

an on/off switch connected between the display lights and the battery pack to turn the display lights on and off;

an electronic flasher module connected to said light bank operative to sequentially flash the light sources of the light bank on and off for the purpose of attracting fish;

said battery pack including a plurality of rechargeable batteries, and a recharging circuit connected to the batteries and a recharging receptacle installed in the housing sidewalls;

and including a metal leader tube passing centrally through the body and jacket and connected to the battery pack for use as part of a circuit in recharging.

30. The fishing lure of claim 29, in which the light sources of said light bank are light emitting diodes.

31. The fishing lure of claim 30, in which the lights are green.

32. The fishing lure of claim 29, including a clear epoxy resin filling the interior space of the housing and encapsulating the items therein.

33. The fishing lure of claim 29, in which the on/off switch is a magnetically actuated reed switch operable through the use of a magnet held exteriorly to the housing.

34. The fishing lure of claim 29, in which the jacket is configured in the likeness of a squid.

35. The fishing lure of claim 29, in which the jacket is removable and interchangeable.

36. A deep sea fishing lure comprising:

a lure body surrounding a housing comprised of light-transmissive sidewalls and an interior space;

at least one bank of multiple, spaced apart, individual electric display lights in the interior space, viewable through the light transmissive sidewalls of the housing;

a fiber optic bundle to transmit light aft from the display lights to outside the lure;

a rechargeable battery pack for the display lights installed in the housing; and

a leader tube, passing centrally through the body to the battery pack, that forms part of a recharging circuit, wherein a leader wire is extendable through the leader wire.

37. The fishing lure of claim 36, further comprising an on/off switch connected between the display lights and the battery pack.

38. The fishing lure of claim 37, in which the on/off switch is a magnetically actuated reed switch operable through the use of a magnet held outside the housing.

39. The fishing lure of claim 36, in which the display lights are light emitting diodes.

40-43. (Canceled)

EVIDENCE APPENDIX

All the evidence related to this Appeal is on the record and before the Board. Therefore, no additional evidence is identified in this Appendix.

RELATED PROCEEDINGS APPENDIX

There are no additional related proceedings to be considered in this Appeal. Therefore, no such proceedings are identified in this Appendix.